

## **REMARKS**

### **Summary of Amendments**

Upon entry of the response and remarks, claims 1 and 2 are amended, whereby claims 1, 3, and 5-7 remain pending. Of the pending claims, claims 1 is independent. Support for amended claim 1 can be found, for example, in original claim 4. In addition, Applicant is amending the specification and claim 2 to clarify the trademark information of "Styrofoam" and to provide its generic chemical name. Applicants submit that no new matter is added.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

### **Foreign Priority**

Applicant notes that the Office Action dated August 2, 2006 does not acknowledge Applicants' claim of foreign priority to Korean Application No. 2003-0079672. Therefore, on the next communication from the Office Applicant respectfully requests acknowledgement of Applicants' claim of foreign priority.

### **Information Disclosure Statement**

Applicants thank the Examiner for consideration of the Information Disclosure Statement filed August 12, 2004, and return of an initialed Form PTO-1449.

**RESPONSE TO CLAIM REJECTIONS****1. Response to Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite because the phrase “the thickness-forming portion” lacks antecedent basis in the claim.

In response to the 35 U.S.C. § 112, second paragraph rejection, Applicant notes that claim 1 has been amended to further clarify the claim and to provide antecedent basis for “the thickness-forming portion.” Therefore, for at least the foregoing reasons, Applicants believe claims 1-4 are clear and definite. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph.

**2. Response to Rejection under 35 U.S.C. § 103(a)**

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over HAN (KR 10 2002 0082710), and further in view of MARTIN (U.S. 4,474,722);

Applicant respectfully requests withdrawal of the obviousness rejection in view of the following remarks. Applicant respectfully submits that a *prima facie* case of obviousness is not established by HAN in view of MARTIN, for at least the following reasons. A *prima facie* case of obviousness requires:

- 1) the presence of all claimed elements,
- 2) the motivation to combine the separate reference teachings, and

3) a reasonable expectation of success.

The Office Action fails to establish any of these requirements.

**(1) The combination of cited documents fails to disclose all elements of the present claims**

First, regarding the presence of all claimed elements, Applicant respectfully submits that even assuming, *arguendo*, that the combination of documents is proper, the requirement that all claimed elements be taught or suggested in the cited documents has not been met.

For instance, with regard to the combination of HAN and MARTIN, Applicant respectfully notes that the cited documents fail to disclose or suggest at least at least “A method of manufacturing a low pressure injection type RIM mold ... to thereby form a RIM mold,” as recited in claim 1. In response to the argument in the Office Action which stated, “[t]he aspect that the mold is to be used in a RIM process is essentially a statement of an intended use for the molded article rather than a manipulative step used to distinguish ‘method’ claims over prior art,” (see Office Action, p. 4), Applicant notes that “a RIM mold” is recited in the claim body, and therefore Applicant’s method distinguishes over the cited documents.

In contrast with the present claims, both HAN and MARTIN fail to disclose or suggest a method of making a RIM mold. For example, MARTIN discloses a method of making hard surface styling concept models. (see Abstract and col. 6, lines 12-22). However, Applicants believe the concept models of MARTIN are

not RIM molds and cannot act as a mold to reproduce articles. Thus, the concept models in MARTIN are merely mock-ups which act as prototypes for concept model cars and the like. Therefore, the combination of HAN and MARTIN fail to disclose or suggest at least “...to thereby form a RIM mold,” and as a result, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Therefore, in view of the above remarks, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection of claims 1-4.

**(2) The Cited Documents Fail to Provide Motivation to Arrive at the Claimed Invention**

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Second, regarding motivation to combine the separate document teachings, to properly establish a *prima facie* case of obviousness, assuming, *arguendo*, that the rejection is based on a proper combination, the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicant respectfully submits that the combination of HAN and MARTIN fail to provide any motivation, let alone specific motivation to arrive at the claimed invention. Applicant respectfully submits that mere statements that “it would have been obvious...” without pointing to specific support in the cited document(s) **is not sufficient** to satisfy the *prima facie* case of obviousness.

For example, both HAN and MARTIN fail to at least provide the specific motivation to arrive at the claimed invention because the cited documents do not

disclose or suggest at least "...to thereby form a RIM mold." Moreover, nothing in HAN or MARTIN cures this deficiency. As noted above, mere statements that "it would have been obvious" without pointing to specific support in the cited document **is not sufficient** to satisfy the *prima facie* case of obviousness.

Therefore, for at least the foregoing reasons, Applicant respectfully submits that the presently claimed method of manufacturing a low pressure injection type RIM mold would not have been obvious in view of HAN and MARTIN. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of claims 1-4.

**(3) There would have been no expectation of success**

Finally, despite the assertions in the Office Action, there would have been no expectation of success of achieving the specific recitations of the present claims. There is no reason to believe that Applicant's particularly claimed method of manufacturing a low pressure injection type RIM mold would have resulted by combining the documents of HAN and MARTIN.

As argued above, the cited documents fail to disclose or suggest at least "...to thereby form a RIM mold." Therefore, one having ordinary skill in the art cannot necessarily conclude that there would have been a reasonable expectation of success to arrive at the presently claimed invention by combining the cited documents of HAN and MARTIN, because one having ordinary skill in the art cannot necessarily conclude that a RIM mold would result, especially in

view of the disclosure of MARTIN, which discloses a method of making hard surface styling concept models. (see Abstract and col. 6, lines 12-22). Applicant believes MARTIN has nothing to do with methods of making RIM molds.

Therefore, Applicants respectfully submit that the presently claimed method of manufacturing a low pressure injection type RIM mold would not have been obvious in view of the documents of HAN and MARTIN. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection.

### **Application is Allowable**

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

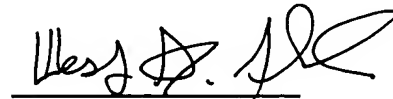
### **CONCLUSION**

In view of the foregoing, it is submitted that none of the cited documents of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicants' invention, as recited in each of claims 1-4. In addition, the applied documents of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
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